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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/723,228	GOINO, TADASHI	
	Examiner	Art Unit	
	Igor Borissov	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/10/2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-8,10-13,16-18,21-27,29,30,32 and 33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6-8,10-13,16-18,21-27,29,30,32 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Amendment received on 1/10/2005 is acknowledged and entered. Claims 4, 5, 9, 14, 15, 19, 20, 28 and 31 have previously been canceled. Claims 1 and 29 have been amended. Claims 1-3, 6-8, 10-13, 16-18, 21-27, 29, 30 and 32-33 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 6, 8, 10-12, 16-17, 24-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al. (US 6,487,538 B1) in view of Benson (US 6,470,079 B1) and further in view of Namanny et al. (US 6,254,478 B1).

Claims 1 and 29. Gupta et al. (hereinafter Gupta) teaches a method and system for conducting a local advertising, said system including a server and a plurality of clients computers interconnected with the server via a network, wherein advertisement is presented to audiences during television or on-line program (C. 4, L. 5-18), and wherein the clients/advertisers can buy an advertisement slot, the price of which depends on advertisement size and slot location on a web page (site) (C. 12, L. 42-47). Furthermore, Gupta teaches that the price also depends on popularity of said web site (the number of times the web site is accessed by the audience), thereby indicating monitoring effectiveness of said television or on-line program. Furthermore, Gupta teaches providing (displaying) client with a web page with an empty advertisement slot, wherein the advertisement slot is the location and space in the web page where the advertisement will be or is placed (displaying position and the size of the

advertisement), and displaying selling price of advertisement rights on the terminal computer of the potential buyer (C. 11, L. 14-19, 28-31, 36, 50-51).

However, Gupta does not specifically teach that said monitoring effectiveness of said television or on-line program includes monitoring effectiveness of an *advertising campaign*. Also, Gupta does not specifically teach that said television or on-line program include a *contest*.

Benson teaches a method and system for real-time reporting of advertising effectiveness, said system including a server and a subscriber's terminal interconnected with the server via a network, wherein the effectiveness of the advertising campaign is monitored and results are reported to the subscriber over the network (C. 2, L. 46-48). The results indicate achievements of the campaign in terms of realized or lost sales (C. 10, L. 19-28).

Namanny et al. (hereinafter Namanny) teaches a method and system for conducting a televised competition, wherein said competition is a motorized racing, and wherein contestants wear clothing with a sponsor's name, trademark or logo (C. 5, L. 59-60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta to include monitoring effectiveness of an advertising campaign, as disclosed in Benson, because it would advantageously allow to discontinue ineffective advertising campaign, thereby save funds (Benson, C. 1, L. 41-44). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson to include that said television or on-line program include a contest, as disclosed in Namanny, because the popularity of sport events would advantageously increase the audience, thereby potentially increase revenue.

Claims 2. Gupta teaches negotiating the price for the advertisement slot over the client's computer (C. 16, L. 12-17).

Claim 6. Gupta teaches negotiating the price for the advertisement slot, said negotiation is conducted over the network between web server and the client's computer (C. 16, L. 12-20), thereby obviously indicating displaying selling price on a home page.

Claim 8. Gupta teaches presenting advertisement to audiences during television or on-line program, wherein the clients/advertisers negotiate the price for the advertisement slot over the network, said price depends on advertisement size and slot location on a web page (site) (C. 4, L. 5-18; C. 12, L. 42-47). Enabling said function obviously indicates providing necessary graphical user interface (GUI). Choosing the contestant is shown in Namanny (C. 7, L. 35-38).
The motivation to combine Gupta in view of Benson and Namanny would be use of the popularity of sport events to increase the audience, thereby potentially increase revenue.

Claim 10. Gupta teaches structuring payment schemes for the advertisement slot based on the popularity of the web site (C. 4, L. 26-29), thereby obviously indicating increasing of the price with increasing audience rating.

Claim 11. Gupta teaches broadcasting a program over the Internet; and the audience rating is obviously indicated by the number of times the web site is accessed by the audience) (C. 4, L. 26-29).

Claim 12. See reasoning applied to claim 1. Information as to: holding the contest *in the theme park* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with

respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Gupta in view of Benson and further in view of Namanny would be performed the same regardless where the contest is taking place.

Claim 16. Namanny teaches clothing (article) with a sponsor's name, trademark or logo; said clothing is worn by the contestants during a sport contest (C. 5, L. 59-60), thereby obviously indicating a plurality of areas for displaying advertisements. The motivation to combine Gupta in view of Benson and Namanny would be to attract big audience to watch a sport contest, thereby potentially increase revenue.

Claim 17. Namanny teaches the contestants wearing clothing with a sponsor's name, trademark or logo during the sport contest (C. 5; L. 59-60). The motivation to combine Gupta in view of Benson and Namanny would be to attract big audience to watch a sport contest, thereby potentially increase revenue.

Claim 24. See reasoning applied to claim 1. Information as to: *the contest is a contest of sumo, kenjutsu, igo, shogi, chess, science, culture or intellect* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The method steps, disclosed in Gupta in view of Benson and further in view of Namanny would be performed the same regardless of the type of the contest.

Claim 25. See reasoning applied to claim 1. Information as to: *wherein the contestant includes an individual, a team, and a work object* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994,*

1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The method steps, disclosed in Gupta in view of Benson and further in view of Namanny would be performed the same regardless who is the contestant.

Claims 3, 7 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny and further in view of Eldering (US 6,324,519 B1).

Claims 3, 7 and 30. Gupta in view of Benson and further in view of Namanny teaches all the limitations of claim 3, except specifically teaching: evaluating amounts proposed by buyers; and determining a successful buyer based on the highest proposed amount proposed by buyers.

Eldering teaches advertisement auction system and method, wherein buyers transmit desired bids from buyers terminals to a server; wherein buyers bid for the advertisement opportunity; the submitted bids are evaluated and the maximum bid is accepted (C. 1, L. 53-55; C. 2, L. 1-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in view of Namanny to include: evaluating amounts proposed by buyers; and determining a successful buyer based on the highest proposed amount proposed by buyers, as disclosed in Eldering, because it would advantageously allow to maximize revenue for providing advertisement opportunity (Eldering, c. 2, L. 20).

Claims 13, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson and further in view of Namanny.

Claims 13 and 22. Gupta in view of Benson and further in view of Namanny teaches all the limitations of claim 13, including providing a number (parameter) of total

calls (sales) during a campaign (Benson, C. 10, L. 25-28), except specifically teaching that the selling price increases as the sales amount (achievements) increases.

However, it is old and well known that increase in popularity (sales) of a product leads to increase in product price. For example, good news about a company usually leads to increasing of company stock value.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in view of Namanny to include that the selling price increases as the sales amount increases, because it would advantageously maximize revenue for the business.

Claim 23. Same reasoning as applied to claims 13 and 22.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny and further in view of Hill (US 5,970,471).

Claim 18. Gupta in view of Benson and further in view of Namanny teach all the limitations of claim 18, except specifically teaching: receiving a selection from the potential buyer of the article; displaying an image of the selected article.

Hill teaches a virtual catalog and product presentation method and apparatus, comprising: displaying a plurality of product images on a display for review by a user; receiving a user input selecting a product image; and displaying the selected product image (C. 3, L. 13-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in view of Namanny to include: receiving a selection from the potential buyer of the article; displaying an image of the selected article, as disclosed in Hill, because it would advantageously allow the user to review/examine the article on the display before he/she make a payment, thereby minimizing return of purchased goods.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny and further in view of Feezell et al. (US 6,253,189) (hereinafter Feezell).

Claim 21. Gupta in view of Benson and further in view of Namanny teach all the limitations of claim 21, except specifically teaching: a ranking coefficient for the contestant, wherein the selling price increases as the ranking coefficient increases.

Feezell et al. (hereinafter Feezell) teaches a method and system for completing advertising time slot transactions, wherein when a time slot for advertisement is offered; a time slot (and program in which the time slot occurs) marketing valuation/rating is conducted and provided to the buyers so that the buyers could accurately value the time slot (C. 3, L. 1-11; C, 7, L 51-52). Rating of the time slot (and program in which the time slot occurs) obviously indicate increase in value of the time slot as the ranking of the time slot increases.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in view of Namanny to include: ranking coefficient for the contestant, wherein the selling price of the time slot increases as the ranking increases, as indicated in Feezell, because it would advantageously allow buyers to evaluate offered time slots and identify those time slots which meet the buyer's requirements, and accurately value the time slots (Feezell; C. 3, L. 10).

Claims 26 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny, further in view of Feezell and further in view of DiCicco et al. (US 5,892,554) (hereinafter DiCicco).

Claim 26. Gupta in view of Benson, further in view of Namanny and further in view of Feezell teach all the limitations of claim 26, including a broadcasting frequency

and broadcasting time (Feezell; C. 8, L. 58-65), except specifically teaching: a zoom ratio of the advertisement.

DiCicco et al. (hereinafter DiCicco) teaches a method and system for inserting static and dynamic images into a live broadcast, wherein zoom ratio of the advertisement can be changed (C. 5, L. 59 – C. 6, L. 6; C. 12, L. 33-48).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson, further in view of Namanny and further in view of Feezell to include: providing a zoom ratio, as disclosed in DiCicco, because it would advantageously allow buyers to evaluate offered time slots and identify those time slots which meet the buyer's requirements, and accurately value the time slots.

Claim 32. DiCicco teaches said method and system for inserting static and dynamic images into a live broadcast, wherein the display position and the display size of the advertisement can be changed (C. 5, L. 59 – C. 6, L. 6; C. 12, L. 33-48).

The motivation to combine Gupta in view of Benson, further in view of Namanny and further in view of Feezell and DiCicco would be to allow buyers to evaluate offered time slots and identify those time slots which meet the buyer's requirements, and accurately value the time slots.

Claim 33. Gupta in view of Benson, further in view of Namanny, further in view of Feezell and further in view of DiCicco teach all the limitations of claim 33, except specifically teaching: using a mouse device for interaction with the buyer's terminal.

However, it is old and well known to use the mouse device for interaction with a computer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson, further in view of Namanny, further in view of Feezell and further in view of DiCicco to include using of a mouse device for interaction with the buyer's terminal, because use of well know interface would advantageously simplify interaction with a computer.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson and further in view of Namanny.

Claim 27. Gupta in view of Benson and further in view of Namanny teach all the limitations of claim 27, except specifically teaching distributing profits from advertising between a contest management company and the player.

However, it is old and well known to pay players of sportsman for wearing a uniform with advertisement thereon.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in-view of Namanny to include distributing profits from advertising between a contest management company and the player, because it would advantageously stimulate famous players to participate in the contest, thereby increase audience.

Response to Arguments

Applicant's arguments filed on 1/10/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art does not disclose the step of displaying an image and the selling price of the advertisement to the potential buyer, it is noted that Gupta specifically teaches providing (displaying) client with a web page with an empty advertisement slot (or slot with advertisement included) wherein the advertisement slot is the location and space in the web page where the advertisement will be or is placed (C. 11, L. 14-19). Furthermore, Gupta teaches displaying selling price of advertisement rights on the terminal computer of the potential buyer (C. 11, L. 50-51).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649 before April 13, 2005, and (571) 272-6801 after that date.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist before April 13, 2005, whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702 before April 13, 2005, and (571) 272-6812 after that date.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

IB

3/28/2005

THOMAS A. DIXON
PRIMARY EXAMINER